

REMARKS

This paper responds to the Final Office Action dated December 10, 2008, and to the Advisory Action dated March 12, 2009. Claims 1, 11, 17, and 22 are amended. Claims 1, 2, 4, 6-23, and 25-30 are now pending in this application.

§102 Rejection of the Claims

Claims 1, 2, 4, 8, 11, 14, 16-18, 20-23, 25, 26 and 28 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,463,585 to Hendricks et al. (*Hendricks*). Since a *prima facie* case of anticipation has not been properly established, Applicant respectfully traverses the rejection.

In order to anticipate a claim, a reference must teach all limitations, arranged or combined in the same way as recited in Applicant's claim. The Court of Appeals for the Federal Circuit recently held

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also *all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." *Net MoneyIn, Inc. v. Verisign, Inc.*, No. 2007-1565 at 17. (Fed. Cir. Oct. 20, 2008). (Emphasis added.)

Because *Hendricks* fails to disclose all limitations of independent claims 1, 11, 17, and 22, these claims are not anticipated, and are thus novel.

In particular, amended claim 1 recites, *inter alia*,

A method of using a trigger in a video stream to *access preferred information associated with a viewer* to display targeted information with a video signal, the method comprising:

...
obtaining a list of addresses of a plurality of targeted information,
said list of addresses based on at least one characteristic of a group of viewers comprising said viewer;

...
selecting an address from said list of addresses of the plurality of targeted information based upon said *trigger and said preferred information*...

obtaining said targeted information corresponding to said selected address using said selected address...

The Examiner asserts that *Hendricks* anticipates the subject matter of claim 1 by switching a viewer to one or more feeder channels during a commercial break and/or by accessing locally-stored advertisements. *Advisory Action* at 2-3. Regarding the switching of a viewer to a feeder channel, the feeder channel comprises a broadcast targeted to a demographic audience. See, e.g., *Hendricks* at col. 58, lines 10-23. As such, switching a viewer to the feeder channel does not comprise a “*list of addresses* based on at least one characteristic of a group of viewers comprising said viewer” and “*selecting an address from said list of addresses* of the plurality of targeted information based upon said trigger and *said preferred information*” as recited by claim 1. Because the feeder channels of *Hendricks* do not comprise a list of addresses from which a specific address may be selected, this rejection must be withdrawn.

Regarding the variation disclosed in *Hendricks* where one or more advertisements are stored in a local memory and played during a break in programming, the locally stored advertisements are not selected and then obtained based on preferred information as recited by claim 1. *Hendricks* discloses that, “[t]he Alternate Advertisement Targeting routine 374 is the software that generates packages of television commercials and advertisements geared towards particular viewers and makes use of a viewer's demographic information and viewing habits to determine those advertisements that are of most interest to that particular viewer.” Col. 68, lines 48-53. More specifically, the subroutines described in *Hendricks* are used to “select a grouping (or selective filter) for each set top terminal 220.” Col. 71, lines 6-7. These final groupings, however, are used to “*assign[] a number of times that it will be shown in a given time frame,*” (Col. 71, lines 11-19 (emphasis added)) instead of as a list from which a selection is made based on a personal profile. As such, the Alternate Advertisement Targeting routine 374 does not “select[] an address from said list of addresses of the plurality of targeted information based upon said trigger *and said preferred information*” as recited in claim 1. Applicant therefore requests that the present rejection be withdrawn.

Further independent claims 11, 17, and 22 each have limitations similar to claim 1 and are asserted to also be allowable for at least the same reasons. Claims 2, 4, 8, 14, 16, 18, 20, 21,

23, and 25, 26, and 28 depend either directly or indirectly from claim 1, 11, 17, or 22 and are allowable for at least the same reasons. Further, these dependent claims may each be patentable for their own limitations.

§103 Rejection of the Claims

Claims 6, 7, 12, 13 and 27 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hendricks* in view of U.S. Patent No. 6,973,665 to Dudkiewicz et al. (*Dudkiewicz*). However, *Dudkiewicz* fails to make up for any of the deficiencies not found in *Hendricks*. Therefore, since each of claims 6, 7, 12, 23, and 27 depend from either claim 1, 11, or 22, they too are allowable for at least the same reasons.

Claims 9, 10, 15, 19 and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hendricks* in view of U.S. Patent No. 5,929,850 to Broadwin et al. (hereinafter *Broadwin*). However, *Broadwin* fails to make up for any of the deficiencies not found in *Hendricks*. Therefore, since each of claims 9, 10, 15, 19, and 29-30 depend from either claim 1, 11, 17, or 22, they too are allowable for at least the same reasons.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned representative at (408) 278-4051 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(408) 278-4051

Date April 9, 2009

By Karen Kaufman
Karen L. Kaufman
Reg. No. 57,239

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 9, 2009.

John D. Gustav-Wrathall
Name Paralegal
Schwegman, Lundberg & Woessner

John D. Gustav-Wrathall
Signature